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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,186	09/29/2003	Rudolph Nobis	END-5212	2665

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

FATH

Office Action Summary	Application No. 10/674,186	Applicant(s) NOBIS ET AL.	
	Examiner Matthew J. Kasztejna	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/13/05 & 6/15/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on June 16, 2005, amended claims 1, 9, 11-14, 16, 18, and 19; and canceled claim 21 are acknowledged. The rejection of claims 12 and 13 under 35 U.S.C. 112, second paragraph is *withdrawn*. Claims 1-4 *stand rejected* under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,533,797 to Stone et al. Claims 5-6 *stand rejected* under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,533,797 to Stone et al. in view of U.S. Patent No. 6,786,865 to Dhindsa. Claims 14-15 *stand rejected* under 35 U.S.C. 103(a). The rejection of claims 10-13 and 16-20 under 35 U.S.C. 103(a) is *withdrawn*. The following new and reiterated grounds of rejection are set forth:

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-4 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,533,797 to Stone et al.

In regards to claims 1, Stone et al. disclose a surgical instrument comprising: a housing 32 adapted for gripping in the palm of a user's hand; and an actuator 34 for actuating an end effector 35 associated with the endoscopic device wherein the actuator is operable by one or more fingers of the same hand, and wherein the actuator

is operable without the use of either of the thumb and index finger of the same hand (see Col. 3, Lines 31-37).

In regards to claims 2-3, Stone et al. disclose a surgical instrument wherein the actuator is operated by squeezing the actuator (see Col. 3, Lines 31-35).

In regards to claim 4, Stone et al. disclose a surgical instrument wherein the handle does not comprise any components selected from the group of components consisting of syringe plungers, pistol grips and scissor grips (see Figs. 7a-d).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,533,797 to Stone et al. in view of U.S. Patent No. 6,786,865 to Dhindsa.

In regards to claims 5-8, Stone et al. disclose a surgical instrument comprising: a housing 32 adapted for gripping in the palm of a user's hand; and an actuator 34 for actuating an end effector 35 associated with the endoscopic device wherein the actuator is operable by one or more fingers of the same hand, and wherein the actuator is operable without the use of either of the thumb and index finger of the same hand (see Figs. 7a-d) but is silent with respect to a device for holding the handle to the hand, wherein the device does not require active gripping by any fingers of that hand.

Dhindsa teaches of an analogous device wherein an endoscope handle assembly that

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is releasably secured to a hand of a user of an endoscope. The endoscope valve assembly can be releasably secured to any part of the user's hand (e.g., palm, thumb, or finger) and can be secured either to the hand that holds the endoscope or to the user's other hand (see Col. 10, Lines 10-29). Furthermore, Dhindsa teaches that the securing element is capable of being a ring that fits over the user's digit (see Col. 10, Lines 30-59). By securing the valve assembly to the user's hand, the user can ensure that the valve assembly can be used with any type of endoscope and can be positioned in a location the user finds convenient. Additionally, a user may not wish to use some types of securing elements with an endoscope (see Col. 10, Lines 1-9). It would have been obvious to one skilled in the art at the time the invention was made to include a device for securing the handle to the users hand in the apparatus of Stone et al. in order to provide freedom to the user's other hand to manipulate additional instrumentation as taught by Dhindsa. Furthermore, it would have been obvious to one skilled in the art at the time the invention was made to include a set of ~~direction~~ directions with the apparatus of Stone et al. to insure proper usage of the apparatus as it is well-known in the art and considered obvious to include directions to any device.

Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,533,797 to Stone et al. in view of U.S. Patent No. 6,786,865 to Dhindsa in further view of U.S. Patent No. 5,152,278 to Clayman.

In regards to claims 10, 12-13 and 16-20, Stone et al. and Dhindsa disclose a surgical instrument wherein the handle is adopted for use with a single hand but are silent with respect to the flexible member having a length of at least .5 meters. Cayman

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teaches of an analogous device relating to an endoscope through which apparatus such as fluid introduction tubes, cutters, balloons, irrigators, aspirators and the like, with rigid or flexible shafts, can be inserted. It is well-known in the art to have an endoscope with a tubular body extending a variety of desired lengths for carrying out among other things, resectioning within a body cavity, opening or conduit with continuous observation by the surgeon. It would have been obvious to one skilled in the art at the time the invention was made to include a flexible member in the apparatus of Stone et al. and Dhindsa having a length of at least .5 meters in order to provide access to desired treatment sites deep within body lumen as taught by Cayman and is well-known in the art.

In regards to claims 11, Stone et al. disclose a surgical instrument wherein the end effector is a cutting blade 35.

In regards to claims 14-15, Stone et al. and Dhindsa disclose a surgical instrument wherein the handle is adopted for use with a single hand but are silent with respect to being in combination with a set of instruction for operating the actuator without the use of the thumb and index finger and wherein the set of instruction is directly associated with a medical device to which the handle is attached. However, it would have been obvious to one skilled in the art at the time the invention was made to include directions with the apparatus of Stone et al. and Dhindsa to insure proper usage of the apparatus as it is well-known in the art and considered obvious to include directions to any device.

Response to Arguments

Applicant's arguments filed June 16, 2005 have been fully considered but they are not persuasive.

Applicant states with respect to claim 1, Stone et al. fail to teach an apparatus wherein the end effector is advancable relative to the housing. However, Stone et al. disclose an object of the invention wherein a control grip assembly is used for controlling the operation of an actuator in a surgical instrument and is well-suited for controlling longitudinal movement of a cutting blade (see Col. 1, Lines 39-44). Therefore, as broadly as claimed, Stone et al. teach of a device wherein the end effector is advancable relative to the housing.

Applicant states with respect to claim 11, Stone et al. fail to teach an end effector selected from a group consisting of biopsy forceps, grasping forceps, surgical scissors, extractors, washing pipes, needles injectors etc. However, Stone et al. disclose the device being well-suited for controlling the opening and closing of the jaws of an articulator (see Col. 1, Lines 39-44).

With respect to claims 7-8 and 14-15, it would have been obvious to one skilled in the art at the time the invention was made to include a set of ~~direction~~ directions with the apparatus of Stone et al. to insure proper usage of the apparatus as it is well-known in the art and considered obvious to include directions to any device. Furthermore, Dhindsa shows various applications of the devices in Figures 21-23, as the valve assembly can be ~~sued~~ used with any type of endoscope and can be positioned in any location the user finds convenient (se Col. 10, Lines 1-9).

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Stone et al. and Dhindsa teach of ~~a~~ control handle assemblies which are adapted for use with a single hand. The apparatus of Dhindsa allows the user to use a single hand to both hold the endoscope and to control the flow of irrigation fluid via a valve assembly 330 having an actuator 338 (see Fig. 23).

Applicant's arguments with respect to claims 10, 12-13 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK

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A handwritten signature in black ink, appearing to read 'Linda C. M. Dvorak', with a large, stylized loop at the end.

LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700